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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,996	06/20/2001	Hideto Kihara	1405.1044	2412
21171	7590	10/20/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			WON, MICHAEL YOUNG	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,996

Applicant(s)

KIHARA ET AL.

Examiner

Michael Y. Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/31/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 2, and 16 have been amended and new claim 20 has been added.
2. Claims 1-20 have been examined and are pending with this action.

Claim Rejections - 35 USC § 112

3. Rejection based on 35 USC 112, 2nd has been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moncreiff (US 5,828,839 A) in view of Pendakur (US 6,502,126 B1).

INDEPENDENT:

As per **claims 1 and 16**, Moncreiff teaches of a communication assistance method performed by a communication assistance device and a computer-readable recording medium on which is recorded a communication assistance program, used in a communication device capable of simultaneously carrying out two-way communication among a plurality of users sharing the same channel (see Fig.1 and col.3, lines 15-20: "Internet"), said communication assistance device and said communication device residing in a user terminal (see col.3, lines 22-29), said method, device, and program comprising:

- correlating conditions relating to a transmission object (see col.5, lines 31-42);
- acquiring from said communication device information relating to said channel in accordance with said conditions and said processings (see 2, lines 8-10 & lines 40-44);
- prior to transmission of said transmission object to said channel, determining based on said acquired channel information whether said transmission object meets at least one of said conditions (see Fig.2; Fig.4; and col.4, lines 29-33 & 38-43);
- conducting at least one of said processings on said transmission object based on said determination results, and sending said processed transmission object via said communication device to said channel (see Fig.2, #88 and col.5, lines 31-34).

Although Moncreiff teaches of correlating conditions relating to a transmission object (see col.5, lines 31-42), Moncreiff does not explicitly teach wherein said correlating is performed with processings for said transmission object or processings for a transmission object sent to the network. Pendakur teaches of correlating conditions

relating to a transmission object with processings for said transmission object or correlating conditions relating to a network with processings for a transmission object sent to said network (see col.2, lines 53-60).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Pendakur within the system of Moncreiff by implementing correlating conditions relating to a transmission object with processings for said transmission object or correlating conditions relating to a network with processings for a transmission object sent to said network within the method of assisting communication because Pendakur teaches that "applications may be developed independently, and therefore may have different levels of data and/or video capabilities, including different number of data and/or file channels for performing data and/or file transfer" (see Pendakur: col.4, lines 41-45). Therefore, to perform the communication appropriately among different or disparate applications, one of ordinary skill in the art would correlate transmission object conditions with the processors ability to fully render the object.

As per **claim 2**, Moncreiff teaches a communication assistance device used in a communication device capable of simultaneously carrying out two-way communication among a plurality of users sharing the same channel (see Fig.1 and col.3, lines 15-20: "Internet"), said communication assistance device and said communication device residing in a user terminal (see col.3, lines 22-29), comprising:

first storage means wherein conditions relating to a transmission object are correlated (see col.5, lines 31-42), and then stored (see col.5, lines 38-40: "channel guide database");

acquisition means acquiring said channel-related information from said communication device in accordance with said conditions and processings (see 2, lines 8-10 & lines 40-44);

determination means determining, based on said acquired channel information, whether at least one of said conditions is met with regard to said transmission object prior to the sending thereof to said channel (see Fig.2; Fig.4; and col.4, lines 29-33 & 38-43); and

execution means carrying out at least one of said processings on said transmission object based on said determination results, and sending said processed transmission object to said channel by means of said communication device (see Fig.2, #88 and col.5, lines 31-34).

Although Moncreiff teaches of correlating conditions relating to a transmission object (see col.5, lines 31-42), Moncreiff does not explicitly teach wherein said correlating is performed with processings for said transmission object. Pendakur teaches of correlating conditions relating to a transmission object with processings for said transmission object (see col.2, lines 53-60). (See claim 1 rejection above for motivation)

As per **claim 19**, Moncreiff teaches a communication assistance method, comprising:

correlating conditions of an object to be transmitted over a communications medium (see col.5, lines 31-42); and

transmitting the object over the communications medium as a processed object if the object meets at least one of the conditions or transmitting the object over the communication medium as an unprocessed object if the object fails to meet any of the conditions (see Fig.2, #56 or #58; and col.4, lines 38-54).

Although Moncreiff teaches of correlating conditions relating to a transmission object (see col.5, lines 31-42), Moncreiff does not explicitly teach wherein said correlating is performed with processings for said transmission object. Pendakur teaches of correlating conditions relating to a transmission object with processings for said transmission object (see col.2, lines 53-60). (See claim 1 rejection above for motivation)

As per **claim 20**, Moncreiff teaches a communication assistance method used in a communication device capable of simultaneously carrying out two-way communication among a plurality of users sharing the same network (see Fig.1 and col.3, lines 15-20: "Internet"), said method including the steps of:

correlating conditions relating to a transmission object to said any network (see col.5, lines 31-42);

acquiring from said communication device at least an identifier of said network and said transmission object (see col.2, lines 20-22: "Web sites" and col.5, lines 38-40: "each channel guide... is associated with a particular carrier in a particular sub-area");

prior to transmission of said transmission object to said network, determining whether said transmission object satisfies at least any of said conditions at the timing when said transmission object is acquired (see Fig.2; Fig.4; and col.4, lines 29-33 & 38-43); and

transmitting said transmission object to the network identified by said acquired identifier via said communication device by conducting a processing corresponding to said satisfied condition or stopping transmission based on said determination result (see Fig.2, #88 and col.5, lines 31-34).

Although Moncreiff teaches of correlating conditions relating to a transmission object (see col.5, lines 31-42), Moncreiff does not explicitly teach wherein said correlating is performed with processings for said transmission object or processings for a transmission object sent to the network. Pendakur teaches of correlating conditions relating to a transmission object with processings for said transmission object or correlating conditions relating to a network with processings for a transmission object sent to said network (see col.2, lines 53-60).

DEPENDENT:

As per **claims 3, 17, and 18**, Moncreiff teaches of further comprising second storage means storing user-dependent user information which corresponds to said conditions and processings (see col.4, lines 40-43), and registration means accepting input of said user information from a user, and storing the same in said second storage means (see Fig.2, #56; and Fig.5-Fig.7).

As per **claim 4**, Moncreiff teaches of further comprising second storage means storing user-dependent user information which corresponds to said conditions and processings (see col.4, lines 40-43), and registration means setting said user information based on said channel information, and storing the same in said second storage means (see Fig.2, #56; Fig.5-Fig.7; and col.5, lines 21-30 & 38-42).

As per **claim 5**, Moncreiff further teaches wherein channel information that said acquisition means acquires from said communication device includes at least information specifying the channel to which said transmission object is to be sent and transmission content (see col.2, lines 38-44).

As per **claim 6**, Moncreiff further teaches wherein channel information that said acquisition means acquires from said communication device includes at least information specifying the channel to which said transmission object is to be sent and transmission content (see claim 5 rejection above), and when said transmission object meets said condition, said execution means notifies a user of said met condition and transmission content, and depending on the response from the user to said notice, either transmits said transmission or cancels such transmission (see Fig.5).

As per **claim 8**, Moncreiff teaches of further comprising second storage means storing attributes of a channel with which said communication device is communicating, wherein: said first storage means stores, as a condition, that the channel to which said transmission object is to be sent has an attribute (implicit: see col.1, line 66-col.2, line 12); and said determination means determines whether said condition is met based on

attributes of the channel to which the transmission object is to be sent, said attributes being stored in said second storage means (see rejections above).

5. Claims 7 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moncreiff (US 5,828,839 A).

As per **claim 7**, although Moncreiff teaches of further comprising second storage means (see claim 3 rejection above), and a first storage means stores as a condition that in a channel to which said transmission object is to be sent (see claim 8 rejection above), and said determination means determines, based on whether or not said transmission object meets said condition (see claim 2 rejection above), he does not explicitly teach that second storage stores users classified into classifications, wherein: said first storage means stores as a condition, the number of users belonging to a classification is within a range.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The comparing and determining if the conditions are met would be performed regardless of the conditions. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ such comparing and determining within the system of Moncreiff by implementing storing as a condition the number of users

belonging to a classification is within a range in said first storage and users classified into classification in said second storage within the communication assistance device because such subjective conditions would categorical compare according to the preference of the system designer and result in the same two determination of whether or not to transmit the object. Furthermore the conditions do not functionally relate to the steps of the method claimed.

As per **claim 9**, Moncreiff teaches of further comprising second storage means correlating the time of the latest message included in said transmission object within said channel with said channel (see abstract, last sentence) and storing this correlated information (inherent). Moncreiff does not teach wherein: said first storage means stores as a condition, that a length of time has elapsed since the latest message was sent into the channel to which said transmission object is to be sent; and said determination means determines whether said transmission object meets said condition based on the time of the latest message in said network to which said transmission object is to be sent (see claim 7 rejection above).

As per **claim 10**, Moncreiff does not explicitly teach wherein, stored as a condition in said first storage means is, that when a communications address is included in said transmission content, said channel to which said transmission object is to be sent and said communications address belong to different computer channel, and said determination means determines whether said transmission object meets said condition based on the domain name of said communication device and the domain

name of the information terminal providing said channel to which said transmission object is to be sent (see claim 7 rejection above).

As per **claim 11**, Moncreiff does not explicitly teach of comprising second storage means storing a correlation table containing degree of relevance between prescribed words, wherein: stored as a condition in said first storage means is, that the content of transmission object does not match the atmosphere of said channel to which said transmission object is to be sent, and said determination means seeks degree of relevance between earlier communication content and content of said transmission object based on said correlation table, and determines whether said transmission object meets said condition by comparing said sought degree of correlation and a reference value (see claim 7 rejection above).

As per **claims 12**, Moncreiff does not explicitly teach wherein stored as a condition in said first storage means is, that the usage rate of a language in previous communications is within a certain range, and said determination means determines the usage rate of said language based on identifiers marking the beginning and end of said language (see claim 7 rejection above).

As per **claim 13**, Moncreiff does not explicitly teach wherein stored as a condition in said first storage means is, that said transmission object contains a word that another user has made a keyword in said channel to which said transmission object is to be sent, and said determination means creates beforehand a list of said keywords based on said acquired channel information, and based on said created keyword list,

determines whether or not said keyword is included in said transmission object (see claim 7 rejection above).

As per **claim 14**, Moncreiff does not explicitly teach wherein stored as a condition in said first storage means is, that said transmission object is not in a format, and said determination means determines whether said transmission object is written in said format or not based on the transmission object acquired from said acquisition means (see claim 7 rejection above).

As per **claim 15**, Moncreiff does not explicitly teach wherein stored as a condition in said first storage means is, that any portion of a communication in previously transmitted object has been selected, and when said transmission object meets said condition, said execution means adds information indicating that said transmission object is a response to said selected message to said transmission object (see claim 7 rejection above).

NOTE: Moncreiff teaches of a condition and the step of determining that condition. By claiming various different conditions when the functionality remains the same, is not functionally distinct, and does not make the invention novel.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 2, 16, and 19 that the references fail to show certain features of applicant's invention, it is noted that the features upon

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which applicant relies (i.e., "preparing a webpage on which the message appears and transmitting the Uniform Resource Locator (URL) of the webpage on which the message appears over a network channel") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments with regarding inherency have been considered but are moot in view of the new ground(s) of rejection.

For the reason above, claims 3-6, 8, and 17-18 remain rejected.

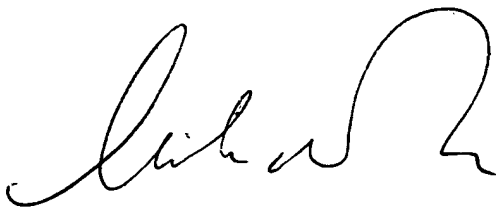
Similarly, for the reasons above, claims 7 and 9-15 remain rejected.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

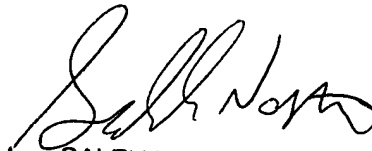
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won



October 14, 2005



SALEH NAJJAR
SUPERVISORY PATENT EXAMINER